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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/599,066	09/19/2006	Ludwig Brehm	1093-162 PCT/US	3721
23869	7590	03/23/2010		
HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			EXAMINER GRABOWSKI, KYLE ROBERT	
			ART UNIT	PAPER NUMBER
			3725	
			MAIL DATE	DELIVERY MODE
			03/23/2010	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/599,066	Applicant(s) BREHM ET AL.	
	Examiner Kyle Grabowski	Art Unit 3725	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 December 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16, 18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16, 18 and 20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-16, 18, and 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Moreau (EP 1,398,174) in view of Cote et al. (US 2005/0040641).

4. In respect to claims 1, 4, 6-7, 14-16, 18, and 20, Moreau discloses a banknote comprising: a paper support 1; a film element 11 having optical security features 15; and a transparent sealing layer 14; the support 1 has window-shaped openings 2 (which may be through holes, 0009) which are closed by the film element 11 which projects beyond it on all sides; the sealing layer 14 covers the film element at least in the region of through holes 2 and is on the opposite side of paper support 1 to film element 11 (0027, Fig. 4).

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5. Moreau does not disclose providing the lacquer layer (broadly synonymous with sealing layer) via a printing, pouring, sprinkling, or spraying method however, Cote et al. teach providing a protective layer lacquer layer comprising, for example, polyethylene terephthalate (PET) (0044) which may be applied as a printed coating of preferably 4 to about 8 microns (0043) and it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the lacquer layer taught in Moreau as a 4 to 8 micron thick PET printed coating as taught in Cote et al. to provide a material and thickness that effectively acts as a barrier to chemical penetration (0043, Cote et al.). Furthermore, the claim would have been obvious because a particular known technique was recognized as part of the ordinary capabilities of one skilled in the art (i.e. providing a sufficient thickness for desired properties is a technique within the purview of one of ordinary skill; similarly providing the lacquer layer through a printing operation is a known technique). The combination of Moreau and Cote et al. teach providing a sealing layer formed of a printed coating and applying it to cover a through hole on a substrate. This combination would result in the sealing layer engaging at least a portion of the cut edges and forming the inner surfaces of the through-hole and engaging the film element. This is due to the physical properties of the lacquer where the thick and viscous coating wraps into inner holes provided between indicia 14, which is analogous to the covered through holes each bearing significant changes in cross section (Fig. 9); Cote et al. specifically teach that the lacquer *fully encapsulates* the material to be protected (Col. 5, 54-61 & Abstract).

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6. In respect to claim 2, Moreau further discloses that the second strip 10 (sealing layer) may be same size as the strip 3 (0023, Fig. 1). Note that the embodiment above in claim 1 incorporates elements of this embodiment (0027).

7. In respect to claim 3, Moreau substantially discloses the claimed subject matter for the reasons stated above including that the sealing layer may be larger than the film element (0023) but does not disclose the particular range of 100% to 120% larger. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a relatively larger sealing layer of 100% to 120%, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.p. Furthermore, Figure 1 shows the sealing layer 10 only marginally larger than film element 3, so apparently just over 100% (i.e. not exceeding 120%).

8. In respect to claim 5, Moreau discloses that optical security feature comprising printing (0015).

9. In respect to claims 8-13, Moreau discloses that the film element may comprise PET (0022). Moreau as modified by Cote et al. teach a PET lacquer layer. Because Moreau as modified by Cote et al. teach the film element and sealing/lacquer lacquer as PET, they share the same material properties such as expansion coefficient, length expansion coefficient, modulus of elasticity, etc. are the same.

10. In respect to claims 14-16, Moreau discloses the claimed subject matter for the reasons stated above.

Response to Arguments

12. Applicant's arguments filed 12/11/09 have been fully considered but they are not persuasive. The applicant presents three main arguments: 1) That Herrmann, incorporated by reference by Moreau, teaches away from claimed subject matter 2) That Cote teaches away from the present invention and 3) That the combination of Moreau and Cote fail to disclose the newly claimed subject matter of "wherein the sealing layer is directly applied to at least a portion of cut edges forming inner surfaces of the through-hole".

13. In respect to the first argument, the examiner respectfully disagrees. It is explicitly disclosed that the method of provide a through hole is incorporated by reference (0009). Several advantages of Moreau are disclosed (0010-0018) which do not mention the fragility of a zone (alluding to a reduced thickness and not a through hole). These advantages are equally served on a document of reduced thickness comprising a through hole, as incorporated by Moreau.

14. In respect to the second argument, the examiner respectfully disagrees. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Cote is attacked for not teaching applying the lacquer to a through hole in a document, however

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Cote was not relied upon for this teaching (Moreau teaches this). Cote was applied solely as a teaching of a type of lacquer layer available in the art.

15. In respect to the third argument, the examiner respectfully disagrees. Cote teaches providing a lacquer layer with the same method, chemical composition, and thickness, and thus it is structurally identical. As stated above, providing the teaching of Cote to Moreau (optionally having a through hole, as incorporated by Herrmann) would result in the claimed structure.

Conclusion

16. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kyle Grabowski whose telephone number is (571)270-3518. The examiner can normally be reached on Monday-Thursday, every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dana Ross can be reached on (571)272-4480. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Kyle Grabowski/
Examiner, Art Unit 3725

/Dana Ross/
Supervisory Patent Examiner, Art
Unit 3725